

Pat. App. No. 10/606,201 filed 6/25/2003
Burd-Mehta, et al.
Reply to Office Action of March 10, 2006

REMARKS/ARGUMENTS

Claims 1–20 are pending in the above-captioned application. Of these, claims 1–3, 7–11, and 17–20 stand rejected, and claims 4–6 and 12–16 are withdrawn from consideration. With this paper, claims 1, 12, and 17–19 have been amended. No new matter was added with the amendment.

I. Application and Claims Status

Applicants have corrected the erroneous status identifiers for claims 4–6, now identifying them as “withdrawn.” Claim 12 has been amended with this paper to remain of the same scope as the product claim and so eligible to be rejoined. Claim 12 is now identified as “withdrawn/currently amended” as requested by the Examiner. The Examiner states that claim 1 was incorrectly identified as being “currently amended.” Applicants respectfully point out that the claim was amended to correct “sets” to “set” to be consistent with “a set of particles” as recited in the claim.

II. Priority

Applicants thank the Examiner for granting the instant application the benefit of priority for 09/510,626 under 35 U.S.C. § 120 and for 60/121,223, 60/127,825, and 60/128,643 under 35 U.S.C. § 119(e).

III. Claim rejections under 35 U.S.C. § 102(e) as allegedly anticipated by Nelson et al. (US 6,007,690)

Claims 1, 2, 8–11, and 17–19 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Nelson et al. (US 6,007,690). This rejection is respectfully traversed. “[F]or anticipation under 35 U.S.C. § 102, a single reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” MPEP § 706.02. “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, USPQ2d 1913, 1920 (Fed. Cir. 1989).

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With regard to independent claims 1 and 17, at a minimum, Nelson et al. do not teach "a broad channel with a narrow channel within the broad channel, wherein the narrow channel is deeper than the broad channel." This limitation has been added to claims 1 and 17 to more particularly point out and distinctly claim Applicants' invention. Support for the limitation can be found on page 12, lines 2-4 of paragraph 0062. That the set of particles is flowed into or disposed within the narrow channel is supported on page 12, lines 4-6 of paragraph 0062. Thus, no new matter has been added by the amendment of the claim.

Thus, Nelson et al. do not teach every aspect of the claimed invention either explicitly or impliedly, nor do they show the identical invention claimed by Applicants in as complete detail as is contained in independent claims 1 and 17. Withdrawal of the rejection of these claims under U.S.C. § 102(e) as being anticipated by Nelson et al. is, therefore, respectfully requested.

Claims 2 and 8-11 depend directly or indirectly from independent claim 1, while claims 18 and 19 depend directly from independent claim 17. Therefore, Applicants respectfully submit that these dependent claims are allowable for at least the same reasons as set forth herein with respect to amended independent claim 1. Withdrawal of the rejection of dependent claims 2, 8-11, 18, and 19 under U.S.C. § 102(e) as being anticipated by Nelson et al. is also respectfully requested.

IV. Claim rejections under 35 U.S.C. § 102(e) as allegedly anticipated by Parce et al. (US 5,942,443)

Claims 1-3, 7, 9-11, and 17-20 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Parce et al. (US 5,942,443). This rejection is respectfully traversed.

With regard to independent claims 1 and 17, at a minimum, Parce et al. do not teach "a broad channel with a narrow channel within the broad channel, wherein the narrow channel is deeper than the broad channel." Thus, Parce et al. do not teach every aspect of the claimed invention either explicitly or impliedly, nor do they show the identical invention claimed by Applicants in as complete detail as is contained in independent claims 1 and 17. Withdrawal of the rejection of these claims under U.S.C. § 102(e) as being anticipated by Parce et al. (US 5,942,443) is, therefore, respectfully requested.

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Claims 2, 3, 7, and 9–11 depend directly or indirectly from independent claim 1, while claims 18–20 depend directly from independent claim 17. Therefore, Applicants respectfully submit that these dependent claims are allowable for at least the same reasons as set forth herein with respect to amended independent claim 1. Withdrawal of the rejection of dependent claims 2, 3, 7, 9–11, and 18–20 under U.S.C. § 102(e) as being anticipated by Parce et al. (US 5,942,443) is also respectfully requested.

V. Claim rejections under 35 U.S.C. § 102(e) as allegedly anticipated by Parce et al. (US 6,429,025)

Claims 1–3, 7, 9–11, and 17–20 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Parce et al. (US 6,429,025). This rejection is respectfully traversed.

With regard to independent claims 1 and 17, at a minimum, Parce et al. do not teach “a broad channel with a narrow channel within the broad channel, wherein the narrow channel is deeper than the broad channel.” Thus, Parce et al. do not teach every aspect of the claimed invention either explicitly or impliedly, nor do they show the identical invention claimed by Applicants in as complete detail as is contained in independent claims 1 and 17. Withdrawal of the rejection of these claims under U.S.C. § 102(e) as being anticipated by Parce et al. (US 6,429,025) is, therefore, respectfully requested.

Claims 2, 3, 7, and 9–11 depend directly or indirectly from independent claim 1, while claims 18–20 depend directly from independent claim 17. Therefore, Applicants respectfully submit that these dependent claims are allowable for at least the same reasons as set forth herein with respect to amended independent claim 1. Withdrawal of the rejection of dependent claims 2, 3, 7, 9–11, and 18–20 under U.S.C. § 102(e) as being anticipated by Parce et al. (US 6,429,025) is also respectfully requested.

VI. Claim rejections under the judicially created doctrine of obviousness-type double patenting

Applicants thank the Examiner for withdrawing the rejection under the judicially created doctrine of obviousness-type double patenting in view of the terminal disclaimer filed on 12/15/2005 with respect to U.S. Patent No. 6,632,655 B1.

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Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,



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Signed: _____

